
REMARKS

This responds to the Office Action mailed on April 18, 2007.

Claims 1, 12, 21, 22 and 25 are amended, claims 3-11, 19, 20, 23, 24, and 26 are canceled, and claims 27-31 are added; as a result, claims 1, 2, 12-18, 21, 22, 25 and 27-31 are now pending in this application.

§103 Rejection of the Claims

Claims 1-2, 4-10, 12-18, 20-25 and 27-29 were rejected under 35 U.S.C. § 103(a) as being unpatentable over US 20040111431 (hereinafter Zeller) in view of US 20030191806 (hereinafter Oster).

The determination of obviousness under 35 U.S.C. § 103 is a legal conclusion based on factual evidence. *See Princeton Biochemicals, Inc. v. Beckman Coulter, Inc.*, 411 F.3d 1332, 1336-37 (Fed.Cir. 2005). The legal conclusion, that a claim is obvious within § 103(a), depends on at least four underlying factual issues set forth in *Graham v. John Deere Co. of Kansas City*, 383 U.S. 1, 17, 86 S.Ct. 684, 15 L.Ed.2d 545 (1966): (1) the scope and content of the prior art; (2) differences between the prior art and the claims at issue; (3) the level of ordinary skill in the pertinent art; and (4) evaluation of any relevant secondary considerations.

The Examiner has the burden under 35 U.S.C. § 103 to establish a *prima facie* case of obviousness. *In re Fine*, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir.1988). To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested, by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974) ; MPEP § 2143.03. "All words in a claim must be considered in judging the patentability of that claim against the prior art." *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970) ; MPEP § 2143.03. As part of establishing a *prima facie* case of obviousness, the Examiner's analysis must show that some objective teaching in the prior art or some knowledge generally available to one of ordinary skill in the art would lead an individual to combine the relevant teaching of the references. *Id.* To facilitate review, this analysis should be made explicit. *KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. ____ (2007)(slip opinion at 14)(citing *In re Kahn*, 441 F. 3d 977, 988 (Fed. Cir. 2006)).

The court in *Fine* stated that:

Obviousness is tested by "what the combined teaching of the references would have suggested to those of ordinary skill in the art." *In re Keller*, 642 F.2d 413, 425, 208 USPQ 871, 878 (CCPA 1981)). But it "cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination." *ACS Hosp. Sys.*, 732 F.2d at 1577, 221 USPQ at 933. And "teachings of references can be combined *only* if there is some suggestion or incentive to do so."

Id. (emphasis in original).

The M.P.E.P. adopts this line of reasoning, stating that:

In order for the Examiner to establish a *prima facie* case of obviousness, three base criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on Appellant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991)).

MPEP § 2142.

The test for obviousness under §103 must take into consideration the invention as a whole; that is, one must consider the particular problem solved by the combination of elements that define the invention. *Interconnect Planning Corp. v. Feil*, 774 F.2d 1132, 1143, 227 USPQ 543, 551 (Fed. Cir.1985). The Examiner must, as one of the inquiries pertinent to any obviousness inquiry under 35 U.S.C. §103, recognize and consider not only the similarities but also the critical differences between the claimed invention and the prior art. *In re Bond*, 910 F.2d 831, 834, 15 USPQ2d 1566, 1568 (Fed. Cir. 1990), *reh'g denied*, 1990 U.S. App. LEXIS 19971 (Fed. Cir.1990). The fact that a reference teaches away from a claimed invention is highly probative that the reference would not have rendered the claimed invention obvious to one of ordinary skill in the art. *Stranco Inc. v. Atlantes Chemical Systems, Inc.*, 15 USPQ2d 1704, 1713 (Tex. 1990). When the prior art teaches away from combining certain known elements, discovery of a successful means of combining them is more likely to be nonobvious. *KSR Int'l Co.*, 550 U.S. ____ (2007)(slip opinion at 12)(citing *United States v. Adams*, 383 U.S. 39, 51-51 (1966)).

Further, the Office Action must provide specific, objective evidence of record for a finding of a suggestion or motivation to combine reference teachings and must explain the reasoning by which the evidence is deemed to support such a finding. *See KSR Int'l Co.*, 550 U.S. ____ (2007)(slip opinion at 14)(citing *In re Kahn*, 441 F. 3d 977, 988 (Fed. Cir. 2006)); *In re Sang Su Lee*, 277 F.3d 1338, 61 USPQ2d 1430 (Fed. Cir. 2002). Finally, the Examiner must avoid hindsight. *In re Bond* at 834.

Additionally, there must be a rational underpinning grounded in evidence to support the legal conclusion of obviousness. *See In re Kahn*, 78 USPQ2d 1329 (Fed. Cir. 2006), which states that, "rejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." *In re Kahn* citing *In re Lee*, 61 USPQ2d 1430 (Fed. Cir. 2002). Additionally, "mere identification in the prior art of each element is insufficient to defeat the patentability of the combined subject matter as a whole." *In re Kahn*.

As noted above, claims 1-2, 4-10, 12-18, 20-25 and 27-29 were rejected under 35 U.S.C. § 103(a) as being unpatentable over US 20040111431 (hereinafter Zeller) in view of US 20030191806 (hereinafter Oster). Claims 1, 12, 21, 22 and 25 are amended while claims 3-11, 19, 20, 23, 24, and 26 are canceled. The pending claims, as amended, do distinguish over the references cited by the Examiner.

For instance, the definition of data sources has been clarified to make it clear that the data sources are disparate data sources. This is supported in a number of places in the specification (see, for instance, the discussion of Figs. 7 and 10-13). None of the references cited describe extracting data from two or more disparate data sources, as described by Applicant and claimed in each of the pending claims. That the data sources are, indeed, different is underscored by the fact that at least one different category of information is stored in each data source.

In addition, none of the references describe "mapping information from each of the plurality of third data sources to second categories, wherein at least one of the second categories is different from the categories associated with the organization data, as described by Applicant and claimed in claims 12-18, 22, 25 and 27-31.

Finally, Applicant has more clearly defined what Applicant means by “linking”. None of the cited references detail “linking employees as a function of the organization information to form a hierarchy of employees and locating the users within the hierarchy of employees, wherein linking includes mapping information from each of the organization information data sources to first categories and storing the mapping in an info set, wherein at least one category present in the first data source is not present in the second data source” as described by Applicant and claimed in each of the pending claims. This is a different approach from that described by Zeller.

Applicant respectfully requests withdrawal of the rejections and reconsideration and allowance of claims 1, 2, 12-18, 21, 22, 25 and 27-31.

Reservation of Rights

In the interest of clarity and brevity, Applicant may not have addressed every assertion made in the Office Action. Applicant’s silence regarding any such assertion does not constitute any admission or acquiescence. Applicant reserves all rights not exercised in connection with this response, such as the right to challenge or rebut any tacit or explicit characterization of any reference or of any of the present claims, the right to challenge or rebut any asserted factual or legal basis of any of the rejections, the right to swear behind any cited reference such as provided under 37 C.F.R. § 1.131 or otherwise, or the right to assert co-ownership of any cited reference. Applicant does not admit that any of the cited references or any other references of record are relevant to the present claims, or that they constitute prior art. To the extent that any rejection or assertion is based upon the Examiner’s personal knowledge, rather than any objective evidence of record as manifested by a cited prior art reference, Applicant timely objects to such reliance on Official Notice, and reserves all rights to request that the Examiner provide a reference or affidavit in support of such assertion, as required by MPEP § 2144.03. Applicant reserves all rights to pursue any cancelled claims in a subsequent patent application claiming the benefit of priority of the present patent application, and to request rejoinder of any withdrawn claim, as required by MPEP § 821.04.

CONCLUSION

Applicant respectfully submits that the claims are in condition for allowance and notification to that effect is earnestly requested. The Examiner is invited to telephone Applicant's attorney (612) 373-6909 to facilitate prosecution of this application.

If necessary, please charge any additional fees or credit overpayment to Deposit Account No. 19-0743.

Respectfully submitted,

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CERTIFICATE UNDER 37 CFR 1.8: The undersigned hereby certifies that this correspondence is being filed using the USPTO's electronic filing system EFS-Web, and is addressed to: Commissioner of Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on this 20th day of August 2007.

KIMBERLY BROWN

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Signature